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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,865	02/04/2000	Donald C. D. Chang	PD-980034	7997
20991	7590	07/17/2006	EXAMINER	
THE DIRECTV GROUP INC			ISSING, GREGORY C	
PATENT DOCKET ADMINISTRATION RE/R11/A109				
P O BOX 956			ART UNIT	PAPER NUMBER
EL SEGUNDO, CA 90245-0956			3662	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/497865

Feb 4, 2000

Donald C. D. Chang

PD-980034

EXAMINER

Issing, G

ART UNIT

PAPER

3662

20060627

DATE MAILED:

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Commissioner for Patents

See attached sheet.

Also attached is a signed and acknowledged copy of the IDS filed 3/27/06.

Gregory C. Issing
Primary Examiner
Art Unit: 3662

Art Unit: 3662

This communication is in response to the Appellants' filing of an amendment after a Decision by the Board wherein the Board entered a new grounds of rejection under 37 CFR 41.50(b).

When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

(A) reopening prosecution before the examiner by submitting an appropriate amendment and /or new evidence (37 CFR 41.50(b)(1)); or

(B) requesting rehearing before the Board (37 CFR 41.50(b)(2)).

In the instant case, the Appellant has attempted to choose option (A).

According to 37 CFR 41.50(b)(1):

the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims.

In the instant case, the Appellant has not submitted an "appropriate" amendment since: (1) the amendment is directed to claims 1-5, 13, 15, 19-21, 23-25, 28 and 29 which were not newly rejected by the Board, and therefore, the amendment is not directed solely to the newly rejected claims, i.e. claims 7-12; (2) the amendment is directed to an issue of overcoming a prior art rejection by amending claims which would require reconsideration of the rejection under 35 USC 103(a), and thus, the amendment is not directed solely to the issues of the new rejection, i.e. 35 USC 112; and (3) the amendment is not directed to the same subject matter since completely new elements are set forth, including, for example, digital beam forming circuitry, second coding circuitry, and a second multiplexer. The reopening of prosecution is limited to the rejected claims for the purpose of overcoming the new rejection set forth by the Board and is not designed to extend the prosecution of the application. According to MPEP 1214.01:

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision

Art Unit: 3662

in which the rejection under 37 CFR 41.50(b) was made includes an affirmation of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution.

Thus, since the amendment filed May 30, 2006 is not appropriate, it will not be entered. Accordingly, the rejection is not overcome. The application file is being returned to the Board so that a decision making the original affirmation final can be entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory C. Issing
Primary Examiner
Art Unit 3662

gci



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/497,865	Feb 4, 2000	Donald C.D. Chang	PD-980034
			EXAMINER
			ISSING, G

DATE MAILED:

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

The petition under 37 CFR §1.97(d)(2)(ii) for consideration of an information disclosure statement filed March 27, 2006 after final action has been:

☒ GRANTED.

☐ DENIED.

The petition lacks:

☐ The required fee under 37 CFR §§1.97(d)(2)(iii) and 1.17(i)(1).

☐ A proper certification as specified in 37 CFR §§1.97(d)(2)(i) and 1.97(e)

The information disclosure statement has been placed of record in the file but will not be considered by the examiner.

Thomas H. Tarcza
SPE Art Unit 3662
571-272-6979